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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,819	04/26/2001	James F. Zucherman	KLYC-01033US4	2799

23910 7590 10/04/2004

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EXAMINER
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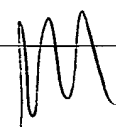
ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/842,819	Applicant(s) ZUCHERMAN ET AL. 	
	Examiner Kathryn Odland	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2001.
- 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-36 and 43-44, drawn to an implant, classified in class 606, subclass 61.
  - II. Claims 37-42, drawn to a method of positioning a spinous process, classified in class 128, subclass 898.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the device can use another method as well as the method can be used with a different device. Further, the method will be dependent upon species.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 3743

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: Figures 1-5b

Species 2: Figures 6-10

Species 3: Figures 11-13

Species 4: Figures 14-15

Species 5: Figures 16-17

Species 6: Figures 18-20

Species 7: Figures 21-22

Species 8: Figures 23-25

Species 9: Figures 26-28

Species 10: Figures 29-30

Species 11: Figures 34-35

Species 12: Figure 36

Species 13: Figure 37

Species 14: Figure 38

Species 15: Figures 39-40

Species 16: Figures 41-42

Species 17: Figure 43

Species 18: Figure 44

Species 19: Figure 45

Species 20: Figures 46-47

Species 21: Figures 48-51

Species 22: Figures 52-55b

Species 23: Figures 56-58

Species 24: Figures 59-60

Species 25: Figure 61

Species 26: Figures 62-63

Species 27: Figures 64-65

Species 28: Figures 66

Species 29: Figures 67-68

Species 30: Figures 69-71

Species 31: Figure 71a

Species 32: Figures 72-73

Species 33: Figure 74

Species 34: Figure 75

Species 35: Figure 76

Species 36: Figure 77

Species 37: Figure 78

Species 38: Figures 79-80 and 81-87

Species 39: Figure 80a

Species 40: Figures 88-91

Species 41: Figures 92-92b

Species 42: Figure 93

Species 43: Figure 93a

Species 44: Figure 93b

Species 45: Figure 93c

Species 46: Figure 93d

Species 47: Figure 94

Species 48: Figure 94a

Species 49: Figure 94b

Species 50: Figure 95

Species 51: Figure 95a

Species 52: Figure 96

Species 53: Figure 97

Species 54: Figure 98

Species 55: Figures 99-100

Species 56: Figures 101-102a

Species 57: Figure 103

Species 58: Figure 104

Species 59: Figure 105

Species 60: Figure 106

Species 61: Figure 107

Species 62: Figures 108-110

Species 63: Figures 111-117

Species 64: Figures 119a-124c

Species 65: Figure 125

Species 66: Figure 126

Species 67: Figure 127

Species 68: Figure 128

Species 69: Figure 129

Species 70: Figure 130, 131, 132-136

Subspecies 70a: Figure 131a

Subspecies 70b: Figure 131b

Species 71: Figures 137-140

Species 72: Figures 141-143

Body Subspecies:

Subspecies 72a: Figure 144

Subspecies 72b: Figure 145

Subspecies 72c: Figure 146a-146c

Adjustment devices:

SubSpecies A: Figures 147a-147b

SubSpecies B: Figures 148a-148b

SubSpecies C: Figures 149a-149b

Species 73: Figure 150

Species 74: Figure 151

Species 75: Figures 152-154c

Hook Subspecies:

Subspecies 75-1a: Figures 155a-155c

Subspecies 75-1b: Figures 155d-155e

Shaft Subspecies:

Subspecies 75-2a: Figure 156

Top Subspecies:

Subspecies 75-3a: Figure 157

Hub Subspecies:

Subspecies 75-4a: Figures 158a-158b

Hook/Shaft Subspecies:

Subspecies 75-5a: Figure 159 **(NOTE: The Brief Description of the drawings states Figure 159a while the drawings show a Figure 159)**

Sleeve Subspecies:

Subspecies 75-6a: Figure 160

Applicant must elect a single species and, if applicable, a single subspecies for each category.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.



Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

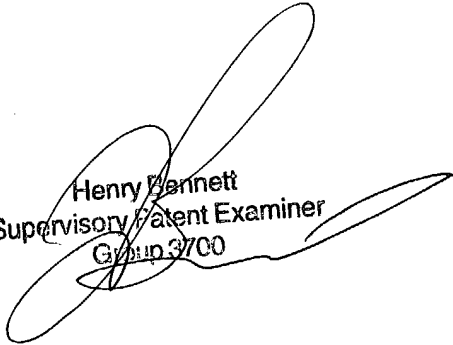
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



Henry Bennett  
Supervisory Patent Examiner  
Group 3700